Arguments/Remarks:

Claims 1-32 are pending and stand rejected. In this response, applicant has amended claims 1, 3, 7, 13, 20, 22-26 and 32. Accordingly, claims 1-32 are presented for reconsideration.

Objection to the Drawings

The drawings are objected to for not showing the sensor element of claims 9, 11, 12, 28, 30 and 31. Applicant has amended the specification to overcome this objection. Withdrawal of the objection is respectfully requested.

Rejections Under 35 U.S.C. § 112

The Office Action sets forth at page 3 "Claims 3, 13, 22-26, 28, 30, 31, and 32 are rejected under 35 U.S.C. 112, second paragraph..." Applicant has appropriately amended these claims and respectfully requests, therefore, that the rejection of claims 3, 13, 22-26, 28, 30, 31 and 32 be withdrawn.

Rejections Under 35 U.S.C. § 102

The Office Action sets forth at page 4 "Claims 1-8, 20-30, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Ash (U.S. Patent 1833879)." Applicant respectfully traverses this rejection for the reasons set forth below.

Applicant's invention is a method for mounting a wheel onto a rim. In accordance with the invention a wheel which has a predetermined wheel imbalance is provided. The wheel imbalance lies within a predetermined tolerance range around a predetermined target value. The predetermined balance is provided at a position of the wheel that is located opposite to the location for accommodating a functional element. An example of such a functional element is a valve stem and/or sensor element of a tire pressure measurement system (TPMS).

Applicant's invention as recited in claim 1 includes features not disclosed or suggested by Ash, namely:

> ... providing a wheel rim having a predetermined wheel rim imbalance and having a specifically designed location for accommodating a functional element, wherein the magnitude of

> imbalance of the wheel rim is within a predetermined tolerance range around a predetermined target value at a position of the wheel rim which lies opposite to the location for accommodating the functional element ...
>
> ... providing a counterbalancing weight element which is designed such that it can be attached at the location for accommodating the functional element and which is designed such that, after having been attached to the wheel rim at the location for accommodating the functional element provides the wheel rim in a ready-to-use condition with an imbalance of a magnitude, within a predetermined tolerance range, which corresponds to the imbalance of the tire ...
>
> ... and then ...
>
> ... mounting the tire to the wheel rim in such a positional relation with respect to the wheel rim that the position of the imbalance of the tire lies opposite to the location for accommodating the functional element so that after mounting of the tire to the wheel rim the magnitude of imbalance of the wheel ready to be driven is below a predetermined threshold value. (Emphasis added)

Ash is relied upon as "[disclosing] a balancing element for a tire and wheel assembly comprising a plurality of weights arranged around a wheel rim." Ash does not disclose or suggest, however, i) providing a wheel rim having a predetermined wheel rim imbalance which lies opposite to the location for accommodating a functional element, ii) providing a counterbalancing weight element that can be attached at the location for accommodating the functional element, and iii) mounting the tire to the wheel rim in such a positional relation with respect to the wheel rim that the position of the imbalance of the tire lies opposite to the location for accommodating the functional element.

In contrast, applicant's invention as recited in claim 1 requires a wheel rim having a predetermined wheel rim imbalance and having a specifically designed location for accommodating a functional element. The wheel rim imbalance being in a position of the wheel rim which lies opposite to the location for accommodating the functional element, providing a counterbalancing weight element which is designed such that it can be attached at the location for accommodating the functional element, attaching the counterbalancing weight element at the location for accommodating the functional element and then mounting the tire to the wheel rim in such a positional relation with respect to the wheel rim such that the position of imbalance of the tire lies opposite to the location for accommodating the functional element.

This provides an advantage in that the balancing of the tire wheel assembly is effected prior to mounting the tire to the wheel so that no additional balance test is necessary afterwards. In addition, the weight for effecting the balance of the tire-wheel assembly is mounted at the inside of the wheel rim so that it cannot be detached or damaged for instance when the wheel rubs against a curb. Such damage reduces the effectiveness of an externally mounted wheel weights and causes imbalance in the tire-wheel assembly.

Ash does not have this advantage because Ash does not i) provide a wheel rim having a predetermined wheel rim imbalance which lies opposite to the location for accommodating a functional element, ii) provide a counterbalancing weight element that can be attached at the location for accommodating the functional element, and then iii) mount the tire to the wheel rim in such a positional relation with respect to the wheel rim that the position of the imbalance of the tire lies opposite to the location for accommodating the functional element.

Because Ash fails to disclose each and every feature of applicant's claimed invention, applicant respectfully submits that the rejection of claim 1 as being anticipated by Ash is improper, should be withdrawn and the claim allowed.

Although not identical, claim 20 includes features similar to those of claim 1 and, thus, is likewise is not subject to rejection for at least the reasons set forth above with respect to claim 1.

Claims 7-8 depend upon claim 1 and claims 21-30 and 32 depend upon claim 20 and, thus, are likewise not subject to rejection for at least the reasons set forth above with respect to claims 1 and 20.

Rejections Under 35 U.S.C. § 103

The Office Action sets forth at page 5 "Claims 9-11 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ash." Applicant respectfully traverses this rejection for the reasons set forth below.

As mentioned above, Ash does not anticipate claim 1. Accordingly, because claims 9-11 and 13-19 depend upon claim 1 they are likewise not subject to rejection as being unpatentable over Ash for at least the reasons set forth above with respect to claim 1.

The Office Action sets forth at page 6 "Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimura et al in view of Pollard." Applicant respectfully traverses this rejection for the reasons set forth below.

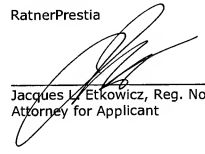
Shimura is relied upon as "[disclosing] a tire valve and tire monitoring system comprising a valve stem and an assembly having sensors...wherein the positioning of the assembly may be moved to adjust the center of gravity of the assembly to prevent an imbalanced condition of the system." Applicant respectfully submits that the "system" imbalance that Shimura refers to is that of the tire pressure sensor itself. Specifically, Shimura's aim is to optimize the balance of the detection apparatus 1 to avoid leakage of air through the mounting of the sensor to the wheel. In other words, Shimura does not disclose or suggest mounting of a functional element to a wheel assembly for the purposes of balancing the wheel assembly. Further, Shimura does not disclose or suggest i) providing a wheel rim having a predetermined wheel rim imbalance which lies opposite to the location for accommodating a functional element, ii) providing a counterbalancing weight element that can be attached at the location for accommodating the functional element, and iii) mounting the tire to the wheel rim in such a positional relation with respect to the wheel rim that the position of the imbalance of the tire lies opposite to the location for accommodating the functional element.

Pollard is relied upon as "[teaching] a tire valve stem and balance weight assembly which is used to counterbalance the imbalance of a tire and wheel assembly." Applicant respectfully disagrees. According to Pollard, he is only concerned with the imbalance caused by a tire, and not any imbalance caused by the wheel. As described in column 2, lines 23-53, "the appropriate valve stem 50 having a weight sufficient to offset the magnitude of the tire imbalance as determined by laser gun 32 from the tire 28 is positioned through the valve stem opening 22." (Emphasis added) Accordingly, Pollard fails to make up for the noted deficiencies above with respect to Shimura. Applicant respectfully submits therefore that the rejection of claims 1-32 as being unpatentable over Shimura in view of Pollard is improper, should be withdrawn and the claims allowed.

In view of the amendments and remarks set forth above, applicant submits that the above-identified application is in condition for allowance which action is respectfully requested.

Respectfully submitted,

RatnerPrestia



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